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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/201,867

11/30/1998

YUTAKA TAKAMI

HIT2944

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05/02/2007

MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.

1800 DIAGONAL ROAD

SUITE 370

ALEXANDRIA, VA 22314

EXAMINER

GREENE, DANIEL LAWSON

ART UNIT

PAPER NUMBER

3694

MAIL DATE

DELIVERY MODE

05/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/201,867

Applicant(s)

TAKAMI ET AL.

Examiner

Daniel L. Greene Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-40 is/are pending in the application.
- 4a) Of the above claim(s) 36,37,39 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-35 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 1998 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 23-40 are currently pending. Claims 23, 36 and 37 were amended in the response received 2/11/2004. Claims 36, 37, 39 and 40 are withdrawn as being directed towards a non-elected invention as set forth below. Accordingly an action on the merits of claims 23-35 and 38 follows.
2. Please note that the Examiner prosecuting the application has changed. All future correspondence should be addressed to Examiner Greene.
3. The Examiner has made a thorough review of the entire prosecution history and in order to maintain clarity of said history makes the following statements:
 - a. The last response to a substantive Office action (mailed 11/03/2003) was received on 2/11/2004. In said response applicant requested an interview. Said interview was conducted with Examiner Colbert on 5/4/2004.
 - b. Applicant's arguments appear to revolve around the feature that the references of record fail to disclose a switching circuit switching between a first and second path wherein said first path is connected to a first external device and said second path is connected to a data processor. This concept appears to be what an external modem does as it's primary function however the prior Office actions do not appear to set forth a clear and concise explanation of how such is so. Therefore the Examiner withdraws the rejections set forth in sections 5-25 of said previous Office action mailed 11/03/2003 and sets forth new rejections as applied to the amended claims as explained in detail below.

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Election/Restrictions

4. Applicant's election without traverse of Invention I, i.e. claims 23-35 and 38 in the reply filed on 11/13/2006 is acknowledged.

5. Claims 36, 37 39 and 40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/13/2006.

Response to Amendment

6. The Abstract received 5/27/2004 is objected to for the one of the same reasons set forth in the previous Office action mailed 3/13/2000. The Abstract still uses the word "SAME" in line 8. This word should be replaced with the noun it represents to remove the ambiguity it injects into the abstract.

Drawings

7. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because Figures 3, 4, 6, 7, 14, 19 and 20 each contain functional flow diagrams that have improperly labeled decision boxes. That is, for example, in figure 3, blocks 305, 307, and 308 do not have the "NO" decision labeled and in Figure 4 the "YES" decision states "ELECTRONIC MONEY MOVE INSTRUCTION SIGNAL WAS GIVEN" instead, which is considered to mean "yes". The other figures continue the same or similar discrepancies. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark

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Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. **Claims 23-35 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,623,547 to Jones et al (Jones) in view of either U.S. Patent 5,666,402 to Griffin or U.S. Patent 5,164,985 to Nysen et al. (Nysen)**

Regarding claim 23 Jones teaches a terminal device used in an electronic money system comprising a data processor which processes data in an IC card storing electronic money information (col. 2 line 15-45) and a communication circuit which communicates with a second external device through a public line (col. 4 lines 6-12)(Fig 1/5)(col. 5 line 41) a switching circuit which switches between a first path and a second path (col. 5 lines 48-52) said first path outputting data input from a first external device (col. 5 line 49) to said communication circuit and said second path outputting electronic money data from said data processor to said communication circuit(Fig 1/1 b/2b/3b)(col. 4 lines 1-18).

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Jones does not appear to explicitly disclose a control circuit, which controls a data processor to switch from a first path to a second path at a time of transaction of electronic money.

Resort may be had to either Griffin (See for example, Figure 1, 2, 3C, Col. 1 lines 33-35, 65+ through col. 2 lines 6, col. 4 lines 18-24, col. 8 lines 20-24, claims 23 and 24, etc.) or Nysen (See for example, Fig 1., col. 2 lines 66 through Col. 3 lines 6, etc.) to teach a control circuit which controls said data processor, said communication circuit, and said switching circuit wherein, said control circuit controls said switching circuit to switch from said first path to said second path wherein it is understood that applicant's claim language can be broken down into more simplified terms such as;

a terminal device = a modem

a data processor = that within Jones Pocket exchange device Figure 6.

a communication circuit = the circuit within the modem

a first communication device = Jones Fig. 1 items 10 and 11, i.e. the vendors terminal

a second external device = Jones computers 1a, 2a, 3a

a switching circuit = the circuit within the modem

a control circuit = the circuit within the modem

Jones sets forth applicant's inventive concept however the claim languages are so convoluted that they obfuscate the invention. Support may be had in reviewing applicant's arguments to the previous rejections of record. That

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is, that the crux of the invention lies in the smart card NOT communicating with the cash register/personal computer/ point of sale (POS) device directly. As applicant argues, this helps to maintain security.

Jones sets forth applicant's invention that is clearly capable of performing the desired or intended use set forth in applicants claim. That is, Applicant's claims are directed towards an apparatus, not a method of performing a transaction. Jones is clearly capable of communicating individually between each and every device disclosed in whatever fashion the user would desire. Review for example, col. 4 lines 1-18 "The electronic purses **may take a number of physical forms**...Communication with the computer will generally be established by telephone and purses may be incorporated in telephones or modems....However **a more generally convenient arrangement is to have a portable purse such as an IC card which is loaded via modem connection either by a device specific to the individual.**" (Emphasis added)

Now, a modem should be considered old and well known as shown by either Nysen or Griffin. It stands to reason that any person who owned a computer or fax machine in the late 80's early 90's knew that when either of these devices was using the phone line that he could not make a phone call. That is, only one thing could be done over the dedicated line at a time. This appears to be the concept that applicant has obfuscated within the claim language. That is, the modem can only talk to either the smart card or the cash register, not both at the same time. Whether or not this provides security may be

an added benefit but it is irrelevant. That is, it is considered old and well known that modem devices can only talk to one device at a time.

Again, this appears to be the same thing as being on line and then wanting to make a phone call, only one thing can be done at a time.

At the time of the invention it would have been obvious to one of ordinary skill in the art to have the pocket exchange device of Jones communicate directly with the bank accounting computers set forth in Fig 1. as well as the POS devices via a modem such that only one device at a time communicates with said bank accounting computer as taught to be an old and well known method of communication by modem by either Nysen or Griffin for the benefits of increasing the speed of the transaction, maintaining security, etc.

It is noted that the claim contains statements of intended or desired use.

However, there is well settled case laws that such statements (adapted to) as to possible future acts or to what may happen in a method or operation, are essentially method limitations or statements of intended or desired use and do not serve to patentably distinguish the claimed structure over that of the references. See In Re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 152 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed

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apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is, not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ 2nd 1525, 1528

As set forth in MPEP 2115, a recitation in a claim to the material or article worked upon, does not serve to limit an apparatus claim.

The Examiner has attempted to explain how the references read on the claim language. A review of prior Office actions appears to indicate that applicant is relying heavily upon the Examiners exact citations of columns and line numbers for the exact phraseology set forth in the claims instead of understanding the references teach as a whole. Jones sets forth the basic premise of applicant's invention as well as a plethora of variations that are considered to render applicant's invention obvious. There is no patentability is separating the various functions of the apparatus of Jones when the ultimate result is the same. In re Dulberg, 129 USPQ 348, (CCPA 1961) "It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art."

Claims 24, 25 and 35 are disclosed in, for example, Griffin col. 8 lines 20-25 wherein it is understood that a modem can be connected to many different devices (computer, telephone, etc.) and it automatically switches back and forth between whichever device needs access to the communication line.

Claims 26 and 33 are disclosed in, for example, Jones Figure 7, wherein 22 is the display device (displaying image information, i.e. numbers are images) and 24 is an input device, i.e. keyboard.

Claim 27 is disclosed in, for example, Jones col. 9 lines 24-33.

Claims 28-30 are considered to be nothing more than obvious Variants of charging methods old and well known in the art of charging a battery. Jones sets forth that the PED is battery or solar powered. Accordingly this battery must be charged at some point or the device will no longer function.

Restriction may be required if applicant is not of the opinion that various methods of charging batteries are not well known in the art.

Claims 31, 32 and 34 are disclosed in, for example, Jones Col. 4 lines 17 wherein it is understood that infra-red light is a well known method of wireless communication capable of performing the intended uses set forth in applicant's claims. Again, applicant's claim language is obfuscating the invention, that is, the claims basically set forth that the communication sequence is started by the infrared device, however it is known for infrared systems to auto seek and auto communicate with each other. Again, this is just another method of communication considered to be well known in the art. Again, if applicant is of the opinion that such is not so, then Restriction may be required on this sense as well.

Claim 38 is disclosed in Jones because it is a statement of intended use that Jones is inherently capable of performing. This claim is analogous to saying

I can talk on the phone through my modem when my computer is turned off.

Clearly, Jones is capable of transferring money to or from the IC card regardless of what other systems using the same modem are doing.

10. Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones as applied to claims 23-35 and 38 above in view of either U.S. Patent 4,092,580 to Prinsze and further or U.S. Patent 5,910,652 to Kuriyama.

Jones discloses applicant's invention as explained above. If applicant is of the opinion that Jones does not disclose what is considered obvious variants of battery charging circuits then resort may be had to Prinsze to teach that such circuits are indeed old (more than thirty years) and well known.

As per claims 28-30 Jones teaches a value transfer system having a terminal device according to claim 27(Fig 1/5) as the user's input computer connected by a communication line to a host computer at a bank (col. 5 lines 41-42). Again if applicant is of the opinion that Jones fails to teach the system wherein said storage battery is charged through said communication circuit, an external power source and a selector between the two, then resort may be had to Prinsze.

Prinsze teaches in, for example, the abstract, Figures 1 and 2, col. 1 lines 15-21 and 31-35, col. 2 lines 33-50, claims 1-6, etc. that it is known in the art to supply appliances with rechargeable battery power for the benefits of, for example, ensuring the device will operate as desired with a maximum of convenience (i.e. not having to replace batteries). Prinsze also teaches that the charger should be able to utilize AC or DC sources. Although Prinsze is directed towards a flashlight, claims 1-6 are generic

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and the teachings of charging circuits as they have been applied to multiple devices since the 1970's cannot be overlooked.

At the time of the invention it would have been obvious to one of ordinary skill in the art to apply the teachings of Prinsze to the battery powered pocket exchange device of Jones to allow for the batteries in Jones to be charged by whatever means available including phone lines, solar power, external power sources etc., especially since the owner of the pocket exchange device (PED) would presumably be away from their home environment when shopping. That is, if the batteries of the PED go dead then the shopping experience is over since the IC card cannot be accessed by the PED. Which is also why Jones allows for the IC card to be removed from the PED and used in other embodiments, i.e. cash registers, POS devices etc.

Further resort may be had to Kuriyama to show that it is known in the Portable Terminal IC Card art to provide charging systems from various sources in order to keep the portable terminal compact and low in cost. See for example the abstract, col. 1 lines 49-63 etc.

Accordingly, at the time of the invention it would have been obvious to one of ordinary skill in the art to provide Jones with a method to charge the battery of the PED by any available manner to include the power from the phone lines, wall outlet, solar power etc. for the benefits of minimizing the size of the battery required by said PED as such is no more than the use of well known variants of supplying power.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Inouoe et al. and Takami et al. both show further evidence that switches (selection means, IC card remittance direction switching unit)) were known to access different chips individually one at a time selectively

b. The other art not commented upon are considered as indicating what ~~is~~ **was** known at the time the invention was made.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene Jr. whose telephone number is (571) 272-6876. The examiner can normally be reached on Mon-Fri 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DIG

2007-04-25


ELLA COLBERT
PRIMARY EXAMINER